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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/970,535	10/03/2001	Robert L. Parker	42390P9334	1378

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

EXAMINER	
O'CONNOR, GERALD J	

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/970,535	Parker et al.	
	Examiner	Art Unit	
	O'Connor	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *December 13, 2004 (RCE)*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11-17* is/are pending in the application.

4a) Of the above claim(s) *none* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *March 5, 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the Office action mailed September 3, 2004 has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 13, 2004 has been entered.

Preliminary Remarks

2. This Office action responds to the amendment and arguments filed by applicant on December 13, 2004 in reply to the Office action mailed September 3, 2004.

3. The amendment of claims 11 and 14 by applicant on December 13, 2004 is acknowledged.

Claim Objections

4. Claims 12, 13, 15, and 16 are objected to because of the following informalities: it appears that "by the composite image" (line 3 of claims 12 and 15) was intended to be --in the composite image--; and, that "with the composite image" (line 4 of claims 13 and 16) was intended to be --in the composite image--, which change will be assumed for purposes of further consideration of the claims, hereinbelow. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e)[1] the invention was described in-
>
> > (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> >
> > (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Lunetta et al. (US 2001/0031102).

Lunetta et al. disclose a method of presenting images of personalized merchandise in an electronic commerce transaction comprising: providing an image of an article of merchandise offered for sale by a merchant in an electronic commerce transaction; providing an online consumer with a mechanism for interactively creating personalizing content in real-time using a

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[1] The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) apply to the examination of this application as the application being examined was (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) as amended by the AIPA (post-AIPA 35 U.S.C. 102(e)).

content creation application program provided by a merchant's server system; projecting the personalizing content onto the image of the article of merchandise to produce a composite image representing the article of merchandise as personalized by the personalizing content; and, providing the composite image for display by a client device of the consumer to facilitate the electronic commerce transaction with the merchant.

Regarding claims 12 and 15, the method of Lunetta et al. includes the step of the merchant accepting an order from the consumer to purchase the article of merchandise as personalized in the composite image.

Regarding claims 13 and 16, the method of Lunetta et al. includes the step of fulfilling an order for purchase of the article of merchandise by the consumer, the article of merchandise corresponding to the image of the article of merchandise as personalized in the composite image.

7. Claims 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by von Rosen et al. (US 6,493,677).

Von Rosen et al. disclose a method of presenting images of personalized merchandise in an electronic commerce transaction comprising: providing an image of an article of merchandise offered for sale by a merchant in an electronic commerce transaction; providing an online consumer with a mechanism for interactively creating personalizing content in real-time using a content creation application program provided by a merchant's server system; projecting the personalizing content onto the image of the article of merchandise to produce a composite image

representing the article of merchandise as personalized by the personalizing content; and, providing the composite image for display by a client device of the consumer to facilitate the electronic commerce transaction with the merchant.

Regarding claims 12 and 15, the method of von Rosen et al. includes the step of the merchant accepting an order from the consumer to purchase the article of merchandise as personalized in the composite image.

Regarding claims 13 and 16, the method of von Rosen et al. includes the step of fulfilling an order for purchase of the article of merchandise by the consumer, the article of merchandise corresponding to the image of the article of merchandise as personalized in the composite image.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lunetta et al. (US 2001/0031102), in view of Garfinkle et al. (US 6,017,157).

Lunetta et al. disclose a method of presenting images of personalized merchandise in an electronic commerce transaction, as applied above in the rejection of claim 11, and the method of Lunetta et al. includes the merchant accepting an order from the consumer to purchase the

personalized item displayed in the composite image, but Lunetta et al. do not disclose selling the image itself, they provide the image for free as a means to entice the consumer to purchase the item depicted in the image.

However, Garfinkle et al. disclose a similar method of e-commerce, wherein the item being ordered by the consumer from the merchant is indeed an image.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lunetta et al. so as to include images in the list of customized items for sale, in accordance with the teachings of Garfinkle et al., in order to earn additional profits from greater sales volume by offering and selling a larger selection of customizable items.

10. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over von Rosen et al. (US 6,493,677), in view of Garfinkle et al. (US 6,017,157).

Von Rosen et al. disclose a method of presenting images of personalized merchandise in an electronic commerce transaction, as applied above in the rejection of claim 11, and the method of von Rosen et al. includes the merchant accepting an order from the consumer to purchase the personalized item displayed in the composite image, but von Rosen et al. do not disclose selling the image itself, they provide the image for free as a means to entice the consumer to purchase the item shown in the image.

However, Garfinkle et al. disclose a similar method of e-commerce, wherein the item being ordered by the consumer from the merchant is indeed an image.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of von Rosen et al. so as to include images in the list of customized items for sale, in accordance with the teachings of Garfinkle et al., in order to earn additional profits from greater sales volume by offering and selling a larger selection of customizable items.

Response to Arguments

11. Applicant's arguments filed December 13, 2004 have been fully considered but they are not persuasive.

12. Regarding the argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "that the consumer can interactively create the personalized content in real-time using a content creation application program provided by the merchant's server (e.g., as a web-accessible tool on the server's web site).") are indeed included in the methods of both Lunetta et al. and von Rosen et al.

Regarding Lunetta et al., see, in particular, element 180 in Figure 1, step 704 in Figure 7, paragraph 23, paragraph 37, and paragraph 46.

Regarding von Rosen et al., see, for example, lines 13-19 of the abstract.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.

14. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is (703) 746-3976.

PLEASE TAKE NOTICE that on April 14, 2005 the examiner's telephone and facsimile numbers will be changed, to (571) 272-6787 and (571) 273-6787, respectively.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at (703) 308-5183, or, beginning April 14, 2005, at (571) 272-6788.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (not changing). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC
February 16, 2005

(2-16-05)

Gerald J. O'Connor
Patent Examiner
Group Art Unit 3627